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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,768	03/24/2004	Ralph Fritz Zwirnmann	060960-5014-US	7926

28977 7590 10/05/2006

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EXAMINER

SHAFFER, RICHARD R

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,768

Applicant(s)

ZWIRNMANN ET AL.

Examiner

Richard R. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 4-10, 14, 15, 23, 25 and 27-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11-13, 16-22, 24, 26 and 50-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The amendment to the written specification filed on July 6th, 2006 is acknowledged and accepted by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 55 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application as originally filed does not support the language/limitation of "said plate is at least three times said width of said recessed region."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 11-13, 16, 17, 20-22, 24, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Eisermann et al (US Patent 6,342,055).

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Eisermann et al disclose a an straight elongate bone plate (**Figure 1**) comprising: a top surface (**90**) with an elongate concave recess (the portion on either the left or right side of **Figure 1** recessed more than section **26** and curving up to either **20** or **22**) extending completely between two countersunk fastener holes (**18**); the width of the recess is not greater than the diameter of either fastener hole (**18**); a bottom bone-contacting surface (**28**); the countersunk holes having a first inclined wall (**34**) and a second inclined wall (**36**); and the corner of the plate between edge (**24**) and top surface (**90**) is chamfered (see **Figure 5**).

In regard to claims 12 and 13, applicant did not specify how the angles were being measured, thus according to "an" axis and method for measuring angles, one could arrive at the limitations set forth in claims 12 and 13.

It is also noted that the recitation of "recessed region" could be arbitrarily designated in which the previous rejection could still be applicable. But the current interpretation of the prior art is deemed more appropriate.

Claims 1-3, 11-13, 16-18, 20, 22, 24, 26, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Happonen et al (US Patent Application Publication 2002/0165545).

Happonen et al discloses a straight elongated bone plate (**Figure 1**) comprising: a top surface (**9**); bottom surface (**10**); at least two countersunk fastener holes (**3**); an elongated U-shaped recess (**7**) that extends between two fastener holes (**3**) and having a width less than the diameter of either hole (**3**); side edge chamfers at the corners of the plate (see **Figure 2**); and the plate being made of a resorbable material (**Page 2**,

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0019) such as L-lactide, D-lactide, D,L-lactide, or a cyclic ester (such as glycolide) copolymerized with lactide.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 19, 26 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann et al in view of Cooper et al (US Patent 6,093,201).

Eisermann et al discloses all of the claimed limitations except for the plate being made of a resorbable material and the material selected from the group consisting of 70/30 poly (L, D/L-lactide) and 85/15 poly (L-lactide-co-glycolide). Cooper et al teaches (Column 1, Lines 13 through Column 2, Line 5 and Column 6, Line 51 through Column 7, Line 45) the use of resorbable materials for bone plates 85/15 poly (L-lactide-co-glycolide) copolymer for a resorbable bone plate. Resorbable plates allow bone tissue to replace the material of the plate avoiding subsequent surgery. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the plate of Eisermann et al to be made of a resorbable material to allow the body to generate natural tissue and to avoid subsequent surgery. It would have been further a mere design choice as to what material would be used as taught by Cooper et al including 85/15 poly (L-lactide-co-glycolide) for a resorbable plate. Cooper et al disclose a vast plurality of materials suitable for resorbable plates.

Response to Arguments

Applicant's arguments filed one July 6th, 2006 have been fully considered but they are not persuasive. In regard to Happonen et al not having the recess between the two fastener holes, it is clear from Figure 1 that recesses 7 are found between the holes. Applicant is directed to the definition of between given by Dictionary.com Unabridged V. 1.0.1: *in the space separating* (two points, objects, etc.).

Applicant's arguments regarding Eisermann et al are not persuasive due to the new grounds of rejection, but would not be persuasive under the old grounds due to the broad recitation of "recessed region." A region can be any section selected as a "recessed portion." The new rejection however covers the amended claims as they were intended to define.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer
September 26th, 2006



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER